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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,387	01/31/2001	Herbert F. Cattell	10010009-1	7825

7590 07/16/2003

AGILENT TECHNOLOGIES
Legal Department, 51U-PD
Intellectual Property Administration
P.O. Box 58043
Santa Clara, CA 95052-8043

EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/16/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,387

Applicant(s)

CATTELL, HERBERT F.

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 14,24 and 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,15-23, 25-33, 37-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant's arguments filed 4/30/03 have been fully considered but they are not persuasive.

Claims 37-45 have been newly introduced.

Election/Restrictions

Claims 14-24 and 34-36 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claim Rejections - 35 USC § 112

Claims 1-6, 9-13, 25-33, 37-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claims 37-45 have been newly introduced. No basis has been pointed to in the specification and none is apparent.

Claims 1, 9, 10, 12, 25, and 28 have been amended. No basis has been pointed to in the specification for the changes and none is apparent.

Applicant is invited to point to page and line number in support for the claimed invention.

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Claims 6, 10-13, 28, 31-33, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 28 are confusing in reciting “in accordance with the retrieved biological function data.” This limitation appears to intend that the retrieved biological function data in some way directs the processor to read the array or process information in a different manner based upon the information retrieved. The claims as written do not make clear what positive, active step is to occur nor the criteria determining whether such an action will or will not occur.

Applicant’s reliance upon *Miles Laboratories Inc. v. Shandon Inc.*, 27 USPQ2d 1123, is misplaced. When applicant’s claims are read in light of the specification, the specification does not illuminate to one of ordinary skill in the art what change in “controlling reading or the array or processing information obtained from reading the array, in accordance with the retrieved biological function data.” What applicant envisions happening is completely unclear. Applicant is invited to point to the page and line number of the specification where this aspect of the invention is expanded upon.

Claim 10 has been amended to recite “or communicating a biopolymer identity data.” It is unclear from the claim what is initiating this communication and where or to whom the information is going. The claim is confusing.

Claim 12 appears to be incomplete. It does not appear that communicating an identifier signal alone would result in retrieval of biological function data. Adding the step of retrieving biological function data does not remedy this deficiency. It does not link use of an identifier

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signal with retrieval of information. It appears that a program, protocol or method step is missing. This claim does not appear to further limit the subject matter of claim 10 as the method of claim 10 appears to include the recited communication and retrieval based on its dependency on claim 9. Applicant's assertion that claim 12 provides two alternatives is not understood. Likewise, claim 13 does not appear to be further limiting as the recitation "memory carrying multiple identifiers in association" would appear to be an implicit limitation of claim 9. That is, the method of claim 9 must have the data in a memory and data for multiple identifiers. Applicant has not addressed this implicit limitation.

Claim 26 is confusing in not clearly further limiting the apparatus of claim 25. The limitations of claim 26 are method limitations that do not clearly further define the apparatus, particularly the processor, of claim 25.

Similarly, claims 31-33 are confusing in not clearly further limiting the apparatus of claim 30. The limitations of these claims concern the data communicated but do not further define the apparatus, particularly the processor, of claim 30.

Applicant argues that claims 26 and 31-33 do further define the processor. This is not agreed with as the type of data being processed doesn't change nor is a new piece of data required to be processed.

Claim 31 is confusing in reciting "along with an indication of a suspected feature error." It is not known what information must be communicated to meet this limitation. The meets and bounds of what is intended do not appear to be disclosed. Applicant is improperly reading limitations from the specification into the claims. Furthermore, these are non-limiting examples and do not define what the claim is intended to embrace. Claim 40 is likewise confusing.

Claim Rejections - 35 USC § 102

Claims 1-13, 25-30, 32-33, 37-39, and 42-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Muraca (U.S. Patent Application Publication No. 2002/0168639).

This rejection is maintained for reasons of record as applied to claims 1-13, 25-30, and 32-33.

The claims as amended specify that the biological function data retrieved comprises the gene. The instant specification makes clear this can be limited to the gene name. In addition, the data accessed by Muraca also includes biological function comprising "information on the function of a target of the array or its complement, or the gene from which either originated." (See at least claims 13-16 and 18-20.) As such, Muraca remains anticipatory. Claim 28 is considered to remain anticipated as the claim does not specifically recite what is to be done when the biological function data is retrieved so the fact that it the information is processed in any way is sufficient to meet the limitations of this claim. With respect to claims 30-32, Muraca does not specify whether a single or multiple apparatuses are required to achieve all of the functionality disclosed. As such, a fair reading of Muraca embraces both embodiments.

Claims 1-13, 25-30, 32-33, 37-39, and 42-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Doung et al. (U.S. Patent Application Publication 2002/0177135).

This rejection is maintained for reasons of record as applied to claims 1-13, 25-30, and 32-33.

The claims as amended specify that the biological function data retrieved comprises the gene. The instant specification makes clear this can be limited to the gene name such as HIV.

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As such, Doung et al. remains anticipatory. Claim 28 is considered to remain anticipated as the claim does not specifically recite what is to be done when the biological function data is retrieved so the fact that it the information is processed in any way is sufficient to meet the limitations of this claim. With respect to claims 30 and 32, Doung et al. does not specify whether a single or multiple apparatuses are required to achieve all of the functionality disclosed. As such, a fair reading of Doung et al. embraces both embodiments.

Claims 1-3, 5, 7-12, 25, 27, 29-30, 32-33, 37-39, and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Schembri (GB 2,319,833).

This rejection is maintained for reasons of record as applied to claims 1-3, 5, 7-12, 25, 27, 29-30, and 32-33.

The claims as amended specify that the biological function data retrieved comprises the gene. The instant specification makes clear this can be limited to the gene or biopolymer name. As such, Schembri remains anticipatory. With respect to claims 30 and 32, Schembri does not specify whether a single or multiple apparatuses are required to achieve all of the functionality disclosed. As such, a fair reading of Schembri embraces both embodiments.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

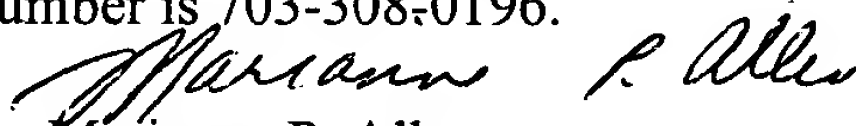
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 8:30 am - 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa
July 14, 2003